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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,798

08/22/2003

Takashi Kawaguchi

116914

8136

25944 7590 05/16/2007
OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

MAIL DATE

DELIVERY MODE

05/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10645798	8/22/03	KAWAGUCHI, TAKASHI	116914

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

Callie E.. Shosho

ART UNIT	PAPER
1714	20070511

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Interview Summary	Application No.	Applicant(s)	
	10/645,798	KAWAGUCHI, TAKASHI	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

All participants (applicant, applicant's representative, PTO personnel):

(1) Callie E. Shosho. (3)_____

(2) Lynn Schwennig. (4)_____

Date of Interview: 11 May 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: all.


Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The interview was based on the office action mailed 12/14/06.

Ms. Schwenning argued that there was no motivation to combine Ma et al. (U.S. 6,247,808) with either Freeman et al. (U.S. 6,716,912) or Arita et al. (U.S. 6,695,443) given that while Ma et al. disclose ink set comprising black ink and color ink, there is no disclosure in either Freeman et al. or Arita et al. of ink set, i.e. each reference only utilizes one ink. Ms. Schwenning further argued that even if one were to combine Ma et al. with either Freeman et al. or Arita et al. there is no disclosure in either Freeman et al. or Arita et al. to utilize the acrylic polymer in the black ink as opposed to the color ink and no motivation to choose using the acrylic polymer in the black ink only. Ms. Schwenning argued that the result of combining Ma et al. with Freeman et al. or Arita et al. would be the use of the acrylic polymer in both the black ink and the color ink of Ma et al. However, Ms. Schwenning argued that there is no requirement in the presently claimed color ink of acrylic polymer.

In response, the examiner argued that given that Freeman et al. and Arita et al. each disclose the use of acrylic polymer in either black ink or color ink, one of ordinary skill in the art could choose which ink to utilize such polymer including the black ink of Ma et al. Ms. Schwenning argued that there is no motivation for one of ordinary skill of the art to choose to use the acrylic polymer of Freeman et al. or Arita et al. in the black ink only. The examiner further argued that even if the combination of Ma et al. with Freeman et al. or Arita et al. resulted in acrylic polymer in both the black ink and color ink of Ma et al., there was nothing in the scope of the present claims to exclude the use of such acrylic polymer in the color ink. That is, in light of the use of open language in the present claims with respect to the color ink, i.e. "comprising", the examiner argued that the color ink was open to the inclusion of such acrylic polymer.

Ms. Schwenning suggested amending claim 1 to recite that the first resin particles are "not acrylic" and that the second resin particles are acrylic in order to distinguish the claims from the prior art and to make clear that each of the inks requires a different resin. The examiner noted that while such an amendment would overcome the rejection of record utilizing Freeman et al. or Ma et al., (i) given the use of such negative limitation, there would be a potential rejection of the claims under 35 USC 112, first paragraph (MPEP 2173.05 (i)) and (ii) in the office action mailed 12/14/06, the examiner also utilized Carlson et al. (U.S. 6,136,890) to meet the limitations of present claim 4 and that Carlson et al. could be used in combination with Ma et al. to meet such proposed limitation.

Ms. Schwenning argued that there was support for such amendment given that the first resin particles do not include acrylic resin. Ms. Schwenning further argued that Carlson et al., like Freeman et al. or Arita et al., only utilizes one ink and provides no motivation for using its polyurethane in the black ink only.

Amending claim 1 to recite "consisting essentially of" transitional language with respect to the color ink was discussed. The examiner noted that if such amendment were made, that while it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. acrylic resin, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention (MPEP 2111.03).